UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,847	09/27/2000	Yoichi Okano	FQ5-488	6526

21254	7590	02/15/2005

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EXAMINER
JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 August 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-11 and 13-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All   b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Based upon the submitted amendment (9-29-2004), examiner notes that claims

1,8,11,18,19,20,21,23,25-27 have been amended and claim 3 has been cancelled.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.·   Claims 1,8,11,18-21,23,25-27 (and all depending claims) rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention.

As per **claims 1,8,11,18-21,23,25-27,** the claims all refer to 'alerting when

it is determined that the predetermined time interval exceeds said amount of time

since the last communication time'. This does not appear to be consistent with

the disclosed invention. If the amount of time since last communication is less

than the predetermined time interval, then there is no reason to alert the user

because the predetermined time interval has not been exceeded. For the purpose

of examination, examiner assumes the word 'exceeds' is replaced with 'is

exceeded by'

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   **Claims 1,3-7,15,18,21,22,25** rejected under 35 U.S.C. 102(b) as being anticipated

by Nazanin et al. (5625683).

As per **claim 1,** Nazanin discloses a mobile telephone (ABSTRACT) with

an alert function. The telephone allows the user to set a predetermined time

duration relative to the end of a call (last-communication time) (Col 3 lines 18-35,

60-67). The 'current time-of-day' referred to by Nazanin will be the last

communication time of day (ie. when the call is terminated) when the user is to be

reminded that a period of time has passed (Col 3 lines 63-66).   The device reads

the current time (Col 2 lines 12-25). The system may use a predetermined period

of time (relative to the last communication) to set a time/date to call the person

(Col 3 lines 63-67). The use of the previously set time/date in relation to the

current time/date is the mechanism by which the phone calculates an amount of

time that has elapsed since the last communication time. Once the current

time/date reaches the previously set time/date, the phone determines that the time

duration has elapsed from the last communication time. Examiner reads the

'current time of day' used to calculate the 'time to call' when the default value is entered as a period of time (Col 3 lines 50-67) as the 'last communication time' since the option to set the time is given to the user immediately after any communication with the person. The unit comprises memory 207 (Fig. 2) that stores the various times/time durations (col 2 lines 20-30). Once the time interval has elapsed, the user is alerted (Col 2 lines 44-52).

As per **claim 18,** Nazanin discloses a device having an alert function that performs the functions described in the rejection of claim 1.

As per **claims 21,22,** claims rejected for same reasons as rejection of claim 1.

As per **claims 25,** claims rejected for same reasons as rejection of claim 18.

As per **claim 4,** when a person is initially called, the last communication time (time-to-call) is initially set to a time at the same time data relating to the person is registered into the phonebook database (Col 2 lines 20-30). The data related to a person may also be read as the time duration entered by the user after terminating a call with the person (Col 3 lines 15-27).

As per **claim 5,** every time communication with a person is terminated, the last communication time is set to the current time value in order to allow the

device to determine when a reminder to call a person back should be sent to the

user (Col 3 lines 63-67).

As per **claim 6,** the time interval is predetermined by the user (Col 3 lines

45-50).

As per **claim 7,** the alerting is done by a speaker vibrator or display (Col 3

lines 50-58).

As per **claim 15,** the device stores an alert list (Col 2 lines 15-30), and

displays the alert list in the form of a menu on a display so that the user may

select to make a call to the person (Col 3 lines 10-28).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 8-10,16,19,26** rejected under 35 U.S.C. 103(a) as being unpatentable over

Nazanin et al. (5625683), and further in view of Smith (5822400).

As per **claim 8,** Nazanin discloses a device as per the rejections of claim 1.

His device is able to store a plurality of persons into memory. However, Nazanin

does not mention dividing the plurality of persons into a plurality of groups and

then determining the before-alert time interval for each group.

Smith (5822400) teaches that many businesses and customer service

organizations utilize telephone systems that include the ability to process a large

number of customer records by grouping them together into campaigns (Col 1,

lines 11-36). It would have been obvious to one of ordinary skill in the art at the

time of this application to divide the plurality of people into a plurality of groups

and then determine the before-alert time interval for each group because this

would gives the system the advantage of being able to process the grouped users

in a batch and enter account records (such as the before-alert time interval) much

more efficiently.

As per **claim 19,** Nazanin in view of Smith discloses a device having an

alert function that performs the functions described in the rejection of claim 8.

As per **claims 26,** claims rejected for same reasons as rejection of claim

19.

As per **claim 9,** claim rejected for same reasons as the rejection of claim 4.

As per **claim 10,** claim rejected for same reasons as the rejection of claim

5.

As per **claim 16,** claim rejected for same reasons as the rejection of claim

15.

6.   Claims 11,13,14,17,20,23,24,27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Nazanin et al. (5625683), and further in view of Groff (4405839).

         As per **claim 11,** Nazanin discloses a device as per the rejections of claim

1. However, Nazanin does not mention storing an alert-inhibition time period in

which alert is inhibited.

         Groff teaches that a telephone subscriber desires to selectively silence the

ringer of his telephone when he doesn't want to be disturbed. Based on this

information, it would have been obvious to one of ordinary skill in the art at the

time of this application to implement an alert inhibition controller so that it could

silence the ringing without having to unplug the telephone (and risk forgetting to

plug the phone back in) (Col 1, lines 11-43).

         As per **claim 20,** Nazanin in view of Goff discloses a device having an

alert function that performs the functions described in the rejection of claim 11.

         As per **claims 23,24,** claims rejected for same reasons as rejection of claim

11.

         As per **claims 27,** claims rejected for same reasons as rejection of claim

20.

As per **claim 13,** claim rejected for the same reasons as the rejection of

claim 7.

As per **claim 14,** Groth additionally mentions that the alert-inhibition

system may optionally inhibit only audio alerts in the telephone (Col 1 lines 50-

55).

As per **claim 17,** claim rejected for same reasons as the rejection of claim

15.

Response to Arguments

7.   Applicant's arguments filed 9-29-2004 have been fully considered but they are not

persuasive.

As per applicant's remarks regarding the Nazanin reference, examiner

contends that the Nazanin reference does disclose the steps as described in the

claim language of claim 1.   The Nazanin reference does disclose a call reminder

system that is based upon the elapsed time (when the time to call is entered as a

time duration Col 3 lines 60-67) since last communication. The use of the

previously set time/date in relation to the current time/date is the mechanism by

which the phone calculates an amount of time that has elapsed since the last

communication time. Once the current time/date reaches the previously set

time/date, the phone determines that the time duration has elapsed from the last

communication time.   The user is given an option to update the reminder time

(either as a time of day or an hour and minute format) every time communication

with a called party is terminated (this is the last communication time) (Col 3 lines 19-35).

As per applicant's remarks regarding the Nazanin reference in view of Smith, examiner contends that the two references are both directed to systems that facilitate phone calls for users. The Nazanin reference discloses the use of a predetermined before alert time period. The Smith reference discloses that user account information may be related to groups of user records (called party phone number lists) (Col 1 lines 10-55) in order to increase processing efficiency. The system in Nazanin easily implements the teachings of Smith by assigning the Default time (already disclosed in Nazanin) to a set or subset of a user's called party phone number list. The motivation provided to combine the references (an increase in processing efficiency) is a valid motivation. The Nazanin reference discloses the entering the before-alert time interval (as described above). The Smith reference teaches to divide called parties into groups in order to enter account records. The prestored DEFAULT value time duration disclosed by Nazanin could be used in view of Smith's teachings to implement groups of called partied where the account information is entered by the group.

As per applicant's arguments regarding the Nazanin reference in view of Groff, examiner contends that the Groff reference is related to a device that inhibits the ringer (alerting system) of a phone during time periods when a user does not want to be disturbed, and the Nazanin reference is related to a phone device that alerts users

As per applicant's comments regarding the Ishihara reference (remarks page 24), there is no Ishihara reference being used in the current set of rejections.

As per applicant's remarks regarding the Groff reference destroying the intended purpose of the Nazanin reference (to remind the user to call a party at a specific time or after a specific time duration when the phone is not offhook or turned off). The examiner contends that the Groff reference teaches an improvement over the Nazanin reference in that the user may specify alert inhibition time period. In Nazanin (Col 2 line 44 to Col 3 line 10) the system already contemplates a situation where the user needs to be alerted, but the phone is powered down or busy. The phone system is able to compensate for these situations without destroying the intended purpose of the phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ
February 9, 2005

CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
ART UNIT 2800